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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,615	09/18/2006	Katsuya Ito	062125	9362

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EXAMINER

CHEN, VIVIAN

ART UNIT	PAPER NUMBER
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1773

MAIL DATE	DELIVERY MODE
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09/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,615

Applicant(s)

ITO ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2007 and 13 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 5, 7 and 9-14 is/are allowed.
- 6) ☒ Claim(s) 6 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claim 4 has been cancelled by Applicant.

Priority

2. In view of the certified English translation of the foreign priority document JP 2003-295631, claims 1-3, 5, 7, 9-14 are deemed to have an effective filing date of 8/13/2007.

However, the certified English translation of JP 2003-295631 does **NOT** provide support for claims 6, 8, which in lieu of a certified English translation of a foreign priority document which provides support for the subject matter of these claims, claims 6, 8 are deemed to have an effective filing date of **08/03/2004**.

Claim Rejections - 35 USC § 103

3. With respect to claims 6, 8, Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers which support the subject matter of these claims has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

4. Claims 6, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

WO 03/074611 (WO '611) and TANAKA ET AL (US 7,115,320);

in view of ULLMANN'S ENCYCLOPEDIA OF INDUSTRIAL CHEMISTRY (ULLMANN'S).

TANAKA ET AL '320 is relied upon solely as an English translation of WO '611.

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WO '611 discloses a polyester film suitable for packaging applications, wherein the film has an elastic modulus of 3-7 GPa, haze values of 0.1-5%, an intrinsic viscosity of up to 1.2 dl/g, heat shrinkage values as recited in claim 1, good pinhole resistance, high impact resistance, and wherein the film comprises a blend of 70-97 wt% polyethylene terephthalate and 3-30 wt% polybutylene terephthalate. The film is optionally coated with an anchor coat and/or a metal or metal oxide layer. (TANAKA ET AL '320, entire document, e.g., line 35-60, col. 2; line 40-55, col. 7; line 42-51, col. 8; line 1-7, col. 9; line 47, col. 9 to line 13, col. 10; Table 3) (see corresponding portions of WO '611)

ULLMANN'S discloses it is well known in the art to apply solutions of adhesion promoting compositions to films via in-line coating in order to improve adhesive properties. (section 2.4.2)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form packaging materials from the film of WO '611. It also would have been obvious to have adjusted the orientation and heat-setting conditions of the film to equalize and minimize shrinkage in both the machine and transverse directions in order to form products with improved dimensional stability and reduced distortion or warping at intended usage temperatures. It also would have been obvious to use known crosslinkable coating formulations with binders and crosslinking (i.e., hardeners) to form durable, water- and solvent-resistant adhesion-promoting coatings on said films (claim 8). Since the films in WO '611 have compositions and mechanical properties similar to those recited in the claims, the Examiner has reason to believe that the impact strength values disclosed in WO '611 (Table 3) are comparable

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to impact strength range recited in claim 1, therefore the Examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald et al.*, 205 USPQ 594.

Response to Arguments

5. Applicant's arguments filed 6/29/2007 and 7/13/2007 with respect to claims 1-3, 5, 7, 9-14 have been fully considered and are persuasive. The rejections of these claims under 35 U.S.C. 103(a) has been withdrawn.

6. Applicant's arguments filed 6/29/2007 and 7/13/2007 with respect to claims 6, 8 have been fully considered but they are not persuasive.

(a) With respect to claims 6, 8, Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers which support the subject matter of these claims has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Allowable Subject Matter

7. Claims 1-3, 5, 7, 9-14 are allowable over the prior art of record.

8. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to disclose polyester films having the recited combination of initial elastic modulus, impact strength, thermal shrinkage characteristics, and haze.

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Rejections based on WO '611 has been overcome in view of the certified English translation of the foreign priority document JP 2003-295631, establishing an effective filing date of 8/13/2003 for these claims.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 14, 2007



Vivian Chen
Primary Examiner
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